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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,171	12/29/2000	Victor R. Sanchez	CAS1PAU24R2	9702

7590

04/09/2003

Myers, Dawes & Andras  
19900 MacArthur Boulevard  
Suite 1150  
Irvine, CA 92612

EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 04/09/2003

DL - 5/9/03

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance  
With 37 CFR 1.192(c) in  
Ex Parte Reexamination**

Control No.

09/753,171

Examiner

Arthur Corbin

Patent Under Reexamination

SANCHEZ ET AL.

Art Unit

1761

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 19 February 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

Patent owner is given a TIME PERIOD of ONE MONTH from the mailing date of this letter or any time remaining in the period under 37 CFR 1.192(a) (whichever is longer) for filing a new complete brief. If a new complete brief that fully complies with 37 CFR 1.192(c) is not timely submitted, the appeal will be dismissed as of the expiration of the period for reply to this Notification. Extensions of this one (1) month time period may be obtained only under 37 CFR 1.550(c). The new complete brief must be filed IN TRIPLICATE \*. See 37 CFR 1.192(a).

1. ☒ The brief does not contain the items required under 37 CFR 1.192(c).
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☒ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☒ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):
  1. The "Grouping of claims" section has been omitted from the Appeal Brief.
  4. The spec. must be referred to by page and line number in the Summary and drawings must be mentioned.
  7. A (separate heading) for each issue must be used.

*no requirement that it must be included*

*they were treated under a separate heading in Issue A*

*Issue B*

\* If this is a merged proceeding, one copy must be added to the base three copies for each reexamination in addition to the first reexamination.

ATTACHMENT

Paragraph (c) (5) of 37 CFR 1.192 requires the following item to be included in appellant's brief:

"(5) Grouping of claims: For each ground of rejection which appellant contests and which applies to more than one claim, it will be presumed that the rejected<sup>ed</sup> claims stand or fall together unless a positive statement is included that the rejected claims do not stand or fall together, and in the appropriate part or parts of the argument under subparagraph (c) (6) of this section appellant presents reasons as to why appellant considers the rejected claims to be separately patentable". It is apparent that 37 CFR 1.192 (c) (5) requires an appellant to perform two affirmative acts in the brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (1) specifically state which claims do not stand or fall together and (2) present arguments why each claim subject to the same rejection is separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (i) omits the statement required by 37 CFR 1.192 9 (c) (5) yet presents arguments in the argument section of the brief or (ii) includes the statement required by 37 CFR 1.192 (c) (5) to the effect that one or more claims do not stand or fall with the rejection of other claims, yet does not offer arguments of support thereof in the

argument section of the brief, the brief is not in compliance with 37 CFR 1.192, and appellant will be notified of the non-compliance as per 37 CFR 1.192(d).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is 703-308-3850. The examiner can normally be reached on Tuesday-Friday from 10 am to 7:30 pm and alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A. Corbin/mn  
April 7, 2003

ARTHUR L. CORBIN  
PRIMARY EXAMINER

4-7-03



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

FEB 20 2003

Commissioner for Patents  
Washington, DC 20231  
[www.uspto.gov](http://www.uspto.gov)

Dear Patent Business Customer:

The United States Patent and Trademark Office ("Office") is now permitting and encouraging applicants to voluntarily submit amendments in a revised format as set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, \_\_\_\_ *Off. Gaz. Pat. Office* \_\_\_\_ (February 25, 2003), currently available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>. The revised format permits amendments to the specification and claims to be made in a single marked-up version; the requirement for a clean version is eliminated. Attached, you will find a flyer with information and instructions regarding the procedures to be used to comply with the revised format. The flyers are being inserted with out-going Office actions mailed during the period of February 20, 2003 - March 31, 2003.

The revised amendment format is essentially the same as the amendment format for the specification, claims, and drawings that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. This proposed revision and others necessary to facilitate a gradual transition to the use of an Electronic File Wrapper (EFW) will be set forth in a Notice of Proposed Rule making (NPR), expected to be published by March 2003. After consideration of public comments, the Office anticipates adopting a revision to § 1.121, following publication of a Notice of Final Rule making (NFR), expected by June 2003, at which point compliance with revised § 1.121 will be mandatory.

The Office will continue to accept your amendment submissions in the revised format during the voluntary period, which will extend up to the effective date of final revisions to § 1.121. The Office also encourages your feedback on the proposed revised amendment format and other changes set forth in the NPR, expected to be published by March 2003.

For assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA), Legal Advisors Elizabeth Dougherty ([Elizabeth.Dougherty@uspto.gov](mailto:Elizabeth.Dougherty@uspto.gov)), Gena Jones ([Eugenia.Jones@uspto.gov](mailto:Eugenia.Jones@uspto.gov)) or Joe Narcavage ([Joseph.Narcavage@uspto.gov](mailto:Joseph.Narcavage@uspto.gov)). Alternately, you may send e-mail to "Patent Practice", the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at (703) 305-1616.

Nicholas P. Godici  
Commissioner for Patents

Attachment: Flyer entitled: *Revised Notice\* AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT*

# Revised Notice\*

## AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT

The United States Patent and Trademark Office (USPTO) is permitting applicants to submit amendments in a revised format as set forth below. Further details of this practice are described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, signed January 31, 2003, expected to be published in *Official Gazette* on February 25, 2003 (Notice posted on the Office's web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>). The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

Effective immediately, **all** applicants may submit amendments in reply to Office actions using the following format. Participants in the Office's electronic file wrapper prototype<sup>1</sup> receiving earlier notices of the revised practice may also employ the procedures set out below.

### REVISED FORMAT OF AMENDMENTS

#### Begin on separate sheets:

Each section of an Amendment (e.g., Claim Amendments, Specification Amendments, Drawing Amendments, and Remarks) should begin on a separate sheet. *For example*, in an amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections must begin on a separate sheet. This will facilitate the process of separately indexing and scanning of each part of an amendment document for placement in an electronic file wrapper.

#### Two versions of amended part(s) no longer required:

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section or claim will be waived where an amendment is submitted in revised format below. The requirements for substitute specifications under 37 CFR 1.125 will be retained.

#### A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated – formerly claim #\_), (previously reinstated), (re-presented – formerly dependent claim #\_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.
- (2) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.
- (3) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

<sup>1</sup> The Office's Electronic File Wrapper prototype program is described in *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002) ("Prototype Announcement"), and applies only to Art Units 1634, 2827 and 2834.